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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,155	03/12/2002	Jiri Nesveda	321402000200	9945

7590 12/16/2002

Kawai Lau  
Morrison & Foerster  
3811 Valley Centre Drive Suite 500  
San Diego, CA 92130-2332

EXAMINER

MILLER, EDWARD A

ART UNIT PAPER NUMBER

3641

DATE MAILED: 12/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/088,155

Applicant(s)

NESVEDA ET AL.

Examiner

Edward A. Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. \*See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical, idiomatic and patent law errors. Complete revision of the claims to be in accord with US practice is required. Note the following exemplary deficiencies.

The claims appear to be a combination of method and composition. While on the one hand, product by process claims are permissible, this does not seem to be the case in this instance. As set forth in *Ex parte Lyell* (BdPatApp&Int) 17 USPQ2d 1548, "a claim which is intended to embrace both product or machine and process is precluded by language of 35 USC 101, which sets forth statutory classes of invention in alternative only, and is also invalid under 35 USC 112, second paragraph, since claim which purports to be both machine and process is ambiguous and therefore does not particularly point out and distinctly claim subject matter of invention." In claim 1, applicant recites combining the energy system and the pyrotechnic system, even though the claims appear to be drawn to a composition. This is compounded by claims 6 and 8-10, which include the further step of applying. Further, do applicants intend to forgo patent coverage as to the exact same composition when made by a different method such as combining ingredients individually, as is the case if a product by process is in fact intended?

In claim 1, line 2, "the energy system" and "the pyrotechnic system" lack antecedent basis. It is not clear what comprises each of these, and further a system would appear to be an apparatus. An apparatus within a composition claims further compounds the plurality of classes of invention

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problem, above. Since these systems are undefined and unknown, the content, or the metes and bounds, of the claims cannot be ascertained. In claim 1, the subparts are not clear. What is included in the oxidizing agent? Recitation of salts of inorganic acids - does this require an inorganic salt or does it include organic salts of inorganic anions? Does it include nitrosyl fluoride? Also, do applicants intend to include such things as carbonates, borates, plumbates, and so on? What is meant by this language? "Complex salts" is indefinite, and cannot be understood. This reads on, for example, sodium barium chloride,  $\text{NaBaCl}_3$ , which is complex but not an oxidizer. Do applicants intend that claims 6 and 8-10 be drawn to intermediate compositions containing acetone? In claims 2-5 and 7, do these claims mean that the composition of claim 1 inherently has all those limitations? "Characterized by the fact that" is a statement, not a further limitation as far as can be understood. Claims 2 and 4 are improper Markush groups.

Further, a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 4 recites the broad recitation complex salts, and the claim also recites "including

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diammo-copper nitrate" [sic] which is the narrower statement of the range/limitation. What is meant by "diammo"? Again, these are merely representative, complete revision is required.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See the rejection above in paragraph 2. It is not clear that the specification describes the invention adequately to support the claims. No new matter may be added to correct deficiencies. It does not appear that the broad terms of the claims, including the oxidizers, are adequately disclosed to enable practice of the invention without undue experimentation.


5. It has been held improper, indeed, reversible error, to rely on speculation as to the meaning of indefinite claims, and then reject that speculative meaning on prior art. *In re Steele*, 305 F.2d 858, 134 USPQ 292 [CCPA 1962], *Ex parte Brummer*, 12 USPQ2d 1653 at 1655 [USPTO BOPAI 1989]. Thus, no examination as to prior art is included at this time.

6. Any inquiry concerning either this or an earlier communication from the Examiner should be directed to Examiner Edward A. Miller at (703) 306-4163. Examiner Miller may normally be reached Monday-Thursday, from 10 AM to 7 PM.

If attempts to reach Examiner Miller by telephone are unsuccessful, his supervisor Mr. Carone can be reached at (703) 306-4198. The Group fax number is (703) 305-7687.

If there is no answer, or for any inquiry of a general nature or relating to the application status, please call the Group receptionist at (703) 308-1113.

Miller/em  
December 15, 2002

  
EDWARD A. MILLER  
PATENT EXAMINER